

REMARKS

Claims 1-17 are pending in this application. Claims 1, 10, and 17 have been amended.

Amendments to the Claims

Applicant amends independent claims 1, 10, and 17 to specify that radiant energy is transmitted to ablate tissue at a target site. Support for this amendment can be found throughout the specification, for example, at paragraph [0044]. No new matter is added.

Rejections under 35 U.S.C. § 102

U.S. Patent No. 5,910,129 to Koblish et al.

Claims 1-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,910,129 to Koblish et al. (hereinafter “Koblish”). Based on the amendments and the following remarks, Applicant respectfully requests reconsideration and withdrawal of the anticipatory rejection.

Independent claim 1, as amended, recites a surgical ablation instrument including a housing, an ablation element, and a fluid channel within the housing. The ablation element is disposable within a lumen of the housing for transmitting *radiant* energy to ablate tissue at a target site.

Koblish fails to teach or even suggest an ablation element that is disposable within a lumen of a housing for transmitting *radiant* energy to ablate tissue at a target site, as required by independent claim 1. Koblish discloses a flexible ablation catheter assembly for transferring ablation energy by *ionic transport*. As shown in Figures 36 and 37 of Koblish, the catheter has a center support lumen (370) enveloped by a porous material (364). The lumen (370) includes spaced-apart electrodes (372) and apertures (374) along its length. In use, fluid is introduced through the lumen (370) and passes through the apertures (374) to ablate tissue. As explained by Koblish, “[t]he porous material 364 has pores capable of allowing transport of ions contained in the fluid material 364 and into contact with tissue.” (Koblish column 21, lines 63-65). Koblish fails to disclose an ablation element for transmitting *radiant* energy to ablate target tissue.

Accordingly, independent claim 1, as well as claims 2-9 which depend directly or indirectly therefrom, distinguish over Koblish and represent allowable subject matter.

Additionally, it would not have been obvious to modify the device of Koblish to include an ablation element for transmitting *radiant* energy because such a modification would change the principle operation of the reference. As explained in §2143.01 of the *MPEP*, “[i]f the proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In reversing an obviousness rejection, the *Ratti* court held that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352. Here, the Koblish ablation device is designed to operate by *ionic transport*. Modifying Koblish to include an ablation element for transmitting *radiant* energy would require removing the existing ablation element in its entirety – the electrodes (372) and porous material (364) – and replacing it with an ablation element configured to transmit radiant energy. In addition to this modification amounting to a substantial reconstruction and redesign of the Koblish device, it also changes the basic principle under which the Koblish construction was designed to operate from ablation via *ionic transport* to ablation via *radiant energy*.

Thus, it would not have been obvious to modify the device of Koblish to include an ablation element for transmitting *radiant* energy to ablate a target region of tissue, and independent claim 1, as well as claims 2-9 which depend directly or indirectly therefrom, represent allowable subject matter.

Independent claims 10 and 17, as amended, relate to a method for ablating a target tissue including: providing a surgical ablation instrument having a housing with a proximal end, a distal end and a longitudinal lumen extending therebetween, the distal end of the elongate housing being sufficiently flexible to be bent into a loop configuration, an ablation element disposed within the lumen of the housing for transmitting *radiant* energy to ablate tissue at a target site, and a fluid channel within the housing for introducing fluid to the ablation element

during delivery of the ablation energy; positioning the surgical ablation instrument proximate to a predetermined tissue site; positioning the ablation element within the lumen of the housing; and transmitting *radiant* ablative energy, such that the target tissue is ablated, coagulated or phototherapeutically modulated without damaging surrounding tissue.

Koblish fails to teach or even suggest a method for ablating a target tissue including transmitting *radiant* ablative energy to ablate tissue at a target site, as required by independent claims 10 and 17. As described above, Koblish discloses a method for ablating tissue using a flexible ablation catheter assembly to transfer ablation energy by *ionic transport*. Moreover, as explained above, it would not have been obvious to modify the device of Koblish to transmit radiant ablative energy, as such a modification would change the principle operation of the reference. Accordingly, independent claims 10 and 17, as well as claims 11-16 which depend directly or indirectly therefrom, distinguish over Koblish and represent allowable subject matter.

Double Patenting Rejection

The Examiner rejects claims 1-17 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/756,645 and claim 1 of copending Application No. 10/756,660. Applicant resubmits terminal disclaimers herewith, correcting a typographical error in the Assignee name and to specify that the Assignee is the owner of 100% interest in the disclaimed patents. Applicant also includes a copy of the Patent Assignment Abstract of Title that demonstrates that Edwards Lifesciences Corporation is the current Assignee. Thus, the basis for the rejections over the copending applications 10/756,645 and 10/756,660 is thereby obviated.

CONCLUSION

In summary, the above-identified patent application has been amended and reconsideration is respectfully requested for all the reasons set forth above. In the event that the amendments and remarks are not deemed to overcome the grounds for rejection, the Examiner is kindly requested to telephone the undersigned representative to discuss any remaining issues.

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Respectfully submitted,

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